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EXAMINER

PASSANITI, SEBASTIANO

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/545,111
Filing Date: April 06, 2000
Appellant(s): ANTONIOUS, ANTHONY J.

WELSH & FLAXMAN LLC
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/28/2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief contains a statement that neither appellant's representative nor appellant's assignee is aware of any related appeals and/or interferences affected by or having a bearing on the Board's decision in the pending appeal.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. Contrary to the notations in the Advisory Action, mailed 12/11/2001, the amendment after final rejection, received 10/30/2001, has been entered for purposes of this pending appeal.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The appellant has acknowledged that claims 1-41 and 63-72 have been rejected as being based upon a defective reissue declaration due to amendments made during the prosecution of the application. From a procedural standpoint, this rejection is maintained for purposes of this examiner's answer. However, the filing of a supplemental declaration may be deferred until the application is in condition for allowance.

(7) *Grouping of Claims*

Appellant's brief contains a statement that claims 63-72 stand or fall together.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-41 and 63-72 STAND rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claims 63-72 STAND rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, as to newly presented claims 63 and 68, the insert is no longer referred to as being "at least as rigid as said tubular section". A review of the original application for the patent shows that the specific phrase "at least as rigid as said tubular section" was part of the language added to the claims and argued by the appellant to specifically overcome the rejections of the original claims and to place the claims in condition for allowance.

Claims 1-41 and 63-72 appear to be allowable over the prior art references of record.

(11) Response to Argument

In the arguments received 12/28/2001, the applicant contends that the inclusion of an insert which is "more rigid" than the tubular section is irrelevant to the alleged error supporting reissue and the recapture rule should not be applied as specified by the Federal Court in *Ball Corp.* In addition, the applicant notes that the narrowing limitations added in new reissue claims 63 and 68 are material to the error which occurred during the prosecution of the original patent application.

Applicant's arguments regarding the recapture issues in this reissue application have been considered, but are not deemed to be persuasive. Applicant's attention is directed to MPEP §1412.02, wherein it is noted that:

"Reissue claims that are broader in certain aspects and narrower in others vis-a-vis claims canceled from the original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). "[I]f the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; [] if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible." *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture."

In this case, applicant's narrowing limitations added to, for example, claims 63 and 68, and including details about the significance of an insert secured at the distal

end of the shaft for enhancing swing control, stiffness and flex control, shock absorption and vibration elimination or reduction, are **not** at all related to the earlier patented limitations calling for an element being "at least as rigid as said tubular section" and the manner in which this phrase defined over the art. Since the narrowing is **not** related to the prior art rejection and **not** related to the subject matter surrendered in the original patent application, recapture exists and the claims are justly rejected under 35 U.S.C. §251.

It is noted that the applicant's argument, that the inclusion of an insert which is "more rigid" is irrelevant, is not deemed persuasive. A review of the prosecution history of the parent application reveals that this limitation was vehemently argued as defining over the prior art rejection of the originally presented claims. See Amendment A, paper no. 7, received 07/03/1996 in the parent application (08/487,247). The broadening aspect of the reissue claim clearly relates to subject matter previously surrendered. The narrowing limitations added through reissue clearly are not at all related to the prior art rejections presented in the parent file and not at all related to the subject matter surrendered in the original patent application. In essence, the scope of the claim has not been changed such that the scope of the claim no longer results in a recapture of the surrendered subject matter. Thus, the narrowing aspect of the reissue claims is completely unrelated to the rejection.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Examiner
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S. Passaniti/sp
January 24, 2002

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